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REMARKS

Applicant carefully considered the final Office Action issued September 13, 2006, and respectfully requests reconsideration of the final rejections of all claims in light of the following remarks.

Initially, Applicant respectfully submits that no basis exists for making the most recent Office Action final. Applicant attacked the obviousness rejections of all claims as lacking *prima facie* support. The examiner apparently agreed with the correctness of the Applicant's position in at least some respects by citing additional support for the rejections, and by further attempting to invoke a procedural mechanism to shift the burden of proving patentability on the Applicant. Since this burden-shifting approach arose for the first time in a final Office Action, Applicant has not had any opportunity to be heard with respect to this issue.

Nothing in the rules or MPEP condones making an Office Action final when a *prima facie* rejection is lacking, and then allegedly made for the first time in a subsequent Office Action when new support is provided. Quite the contrary, the MPEP at Section 706.07 specifically cautions the examiner to "never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." Applicant has not had a "full and fair hearing" with respect to the new support for the rejections made (namely, whether the claims are "product-by-process" claims and recite process steps that can be disregarded in the patentability analysis, which basis for rejection was not in any way necessitated by the addition of claim 24). Accordingly, the examiner should withdraw the finality of the Office Action and give the Applicant an opportunity to respond to the new basis for the rejection and set a proper appeal record.

Turning to the substance of the Action, product claim 1 and method claim 13 stand finally rejected as obvious based on the combination of three references:

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Oleszczuk et al., Lickfield et al., and Welch et al. However, it is still admitted that neither Oleszczuk et al. nor Lickfield et al., "mention at least one adjacent additional layer of different fiber formulation" (Office Action, p. 3, ¶2), as expressly required by these claims. While the contention is made that these references teach that "the layers of the article may be directly thermally bonded" (Office Action, p. 3, ¶1), it is implicitly admitted that neither reference teaches two layers of wet processed mat directly bonded together, as the claims at issue further require. Indeed, the cited passages from the Oleszczuk et al. and Lickfield et al. references specifically teach bonding the wet laid layers 14, 16 with the intermediate layer 12 sandwiched between them, rather than to each other. Accordingly, it is a fact that these "primary" references do not teach bonding the wet laid layers 14, 16 together.

In an effort to supply this missing teaching, the examiner again cites Welch et al. as disclosing that it is "known in the nonwoven laminate art to use an additional nonwoven layer with a different fiber formulation from the adjacent layer, so that the surface is more aesthetically pleasing to the touch and more comfortable to the user" (Office Action, p. 3, ¶3). Even assuming this statement is true, absolutely no teaching, motivation or suggestion of providing directly bonded layers of wet processed mat with different fiber formulations is identified anywhere in Welch et al. or otherwise in the prior art. Indeed, such an arrangement is contraindicated by the Oleszczuk et al. and Lickfield et al. references, since sandwiching a meltblown microfiber layer 12 between the two outer layers 14, 16 is a critical teaching of each of them. In other words, the outer layers 14, 16 are neither of different fiber formulations nor directly bonded together, as the claims under rejection require.

Welch et al. simply does not supply the critical missing teaching of two layers of wet processed mat, as claimed, having different fiber formulations directly bonded together. As Applicant previously pointed out, even if the "second top layer" 105 identified in Welch et al. does have a "different fiber

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formulation," it is neither wet processed, nor is it directly bonded to another wet processed layer, as expressly required by claims 1 and 13.

In response to Applicant's argument in this regard, the examiner contends that "it is not necessary to rely on Welch to teach the wet processing of the layers because Oleszczuk and Lickfield already disclose that additional 'supporting' (wet processed mat) layers may be added to the composite article" (Office Action, p. 7, ¶2) (emphasis added). Applicant respectfully submits that this statement is simply not accurate, since Oleszczuk et al. and Lickfield et al. do not in any of the passages cited by the examiner disclose that an additional "wet processed mat" layer may be added to the article, let alone directly bonded to another wet processed mat layer as required by the claims at issue. The examiner attempts to use an omnibus statement in these references regarding the possible addition of unspecified layers in an unspecified manner in an effort to meet the specific terms of the claims at issue. This type of speculation hardly qualifies as the requisite substantial evidence necessary to support a proper obviousness rejection. See *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001) (recognizing the need for "some concrete evidence in the record in support of" findings of obviousness). Stated another way, no "reasonable mind might accept as adequate" the teachings of Oleszczuk et al. and Lickfield et al. as to the addition of various additional layers as supporting the conclusion advanced by the examiner that a wet processed mat of a different fiber formulation may be directly bonded to the layers 14, 16 disclosed in these references.

Likewise, the ultimate conclusion reached by the examiner regarding the obviousness of the claimed inventions is not supported by the requisite substantial evidence. The examiner concludes based on the teachings of the references that a skilled artisan would have found it obvious to "directly bond an additional wet processed bicomponent staple fiber mat supporting layer, with a different fiber formulation . . . because the additional wet processed bicomponent staple fiber mat supporting layer would allow the surface to be

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more aesthetically pleasing to the touch and more comfortable to the user" (Office Action, p. 3, ¶1). However, not even a scintilla of evidence in the record supports the conclusion that adding a wet processed mat layer having a different fiber formulation would produce this result. As implicitly admitted by the examiner, Welch et al. does not mention any wet processed mat layer directly bonded to another wet processed mat layer of the type claimed having a different fiber formulation, so it cannot support the conclusion reached. Moreover, the examiner expressly admits that Oleczuk et al. and Lickfield et al. "do not appear to specifically mention at least one adjacent additional layer of different fiber formulation" (*Id.*). The examiner's conclusion is thus a *non sequitur*, since the fact that Welch et al. teaches that a different fiber diameter or denier may create a surface more "aesthetically more pleasing to the touch" would not in any way motivate a skilled artisan to directly bond two wet processed mats having different fiber formulations together as required by the claim.

As noted above, the assertion is also made for the first time in this final Office Action that "applicant has not shown, or attempted to show, that all wet processing steps result in a mat that is patentably distinct from a mat that is not wet processed" (Office Action, p. 7, ¶2). Aside from the fact that it is made for the first time in a final Office Action, this statement is troubling for several additional reasons. First of all, none of the claims at issue require any "wet processing steps" whatsoever. Rather, they require a wet processed mat as a structural element of the claimed invention. The remarks made by the examiner in this regard suggest that express structural limitations of the claims (namely, wet processed mats) were ignored in the patentability analysis, which is improper. See MPEP 2143.03 ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

Perhaps more troubling is that the examiner ostensibly attempts to shift the burden of proving patentability to the Applicant, despite the fact that a *prima*

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*facie* case of unpatentability is lacking for the reasons previously provided. The decision cited by the examiner, *In re Marosi* 218 USPQ 289 (Fed. Cir. 1983), as allegedly providing support for shifting the burden of proof to the Applicant to establish patentability is inapposite, and does not in any way justify the examiner's position. In that case, the product claims at issue were "directed to a zeolite manufactured by the claimed process." *Id.* at 291.

Here, in stark contrast, the product claims recite a liner/insulator having multiple layers of wet processed mat bonded together. Limitations such as "wet processed" when applied to claim elements such as mats have long been held to qualify as structural, rather than process limitations. See *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1371-74 69 USPQ2d 1050 (Fed. Cir. 2003) (holding that "multiple embossed patterns" did not import a process limitation into a structural claim); *Hazani v. U.S. International Trade Commission*, 44 USPQ2d 1358 (Fed. Cir. 1997) (holding that the limitation "chemically engraved" in a claim "describes the product more by its structure than by the process used to obtain it."); *In re Garnero*, 412 F.2d 276, 278-79, 162 U.S.P.Q. 221, 223 (CCPA 1969) ("it seems to us that the recitation of the particles as 'interbonded one to another by interfusion between the surfaces of the perlite particles' is as capable of being construed as a structural limitation as 'intermixed,' 'ground in place,' 'press fitted,' 'etched,' and 'welded,' all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations"). Thus, the burden-shifting authorized by *In re Marosi* and relied upon by the examiner in attempting to force the Applicant to establish patentability of the claimed inventions is simply inapplicable to the present situation.

In final analysis, none of the three references cited teach or suggest the inventions of claims 1 and 13 (namely, two wet processed mat layers having different fiber formulations that are directly bonded together). Such a teaching or suggestion is undoubtedly a critical requirement of a *prima facie* case of

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obviousness. See MPEP § 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."). In view of this missing teaching, it also cannot be the case that a skilled artisan reviewing these references would in any way be compelled or motivated to modify the corresponding wet-laid layers 14, 16 of the primary references to be directly bonded. Accordingly, there is simply no motivation to combine the references as proposed, which of course is a further crucial requirement of a *prima facie* case of obviousness. Therefore, claims 1 and 13 as well as claims 2-5, 9-12, 14-15 and 19-22 dependent thereon should be formally allowed, and reconsideration of the final rejections of these claims is respectfully requested.

With regard to claims 6-8 and 16-18, Oleszczuk et al. and Lickfield et al. fail to teach or suggest a liner/insulator including first and second layers of wet processed mat directly bonded together, wherein the first and second layers have different fiber formulations. Welch et al., as described above, does not supply this missing teaching, either, and Insley does nothing to address this shortcoming of the other references. Accordingly, claims 6-8 and 16-18 are believed to patentably distinguish over the cited references, so reconsideration of the final rejections of these claims is respectfully requested.

As for claim 23, which still stands rejected as obvious based on the teachings of five different references, the Oleszczuk et al., Lickfield et al., and Welch references fail to teach or suggest a liner/insulator including first and second layers of wet processed mat directly bonded together where those first and second layers have different fiber formulations. Bansal et al. and Malaney do nothing to address this shortcoming of the other references. Accordingly, claim 23 patentably distinguishes over the cited art and should also be allowed.

As for claim 24, the examiner contends that its terms are met by the cited references because "the first and second layers have different fiber compositions because one layer is composed of fibers with a small diameter while the other

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layer is composed of fibers with a larger diameter" (Office Action, p. 8, ¶2). Although not made clear, it is presumed that the examiner is relying on the Welch et al. reference in support of this statement. Regardless, the statement made ignores the plain and ordinary meaning of the term "composition," which would be understood by an artisan skilled in the chemical arts as meaning "[t]he elements or compounds making up a material or produced from it by analysis."<sup>1</sup> This meaning is entirely consistent with that accorded by Applicant's specification, which describes the fibers of one layer 4 as possibly comprising polyolefins and polyacetate, with the fibers of the other layer 2 including natural fibers such as hemp and kenaf. In contending that the different diameters of Welch et al. qualify as different "fiber compositions," the examiner is improperly construing the claim so as to alter the ordinary meaning of the term "composition," contrary to what would be understood by a skilled artisan. *See In re Cortright*, 165 F.3d 1353, 1358 [49 USPQ2d 1464] (Fed. Cir. 1999) ("Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.") (emphasis added).

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<sup>1</sup> See, e.g., *McGraw-Hill Dictionary of Scientific and Technical Terms* (5th Ed., 1994):

**composition** {CHEM} The elements or compounds making up a material or produced from it by analysis. {GRAPHICS} The act of composing or combining type for printing, either by hand or by machine. {MATH} 1. The composition of two mappings,  $f$  and  $g$ , denoted  $g \circ f$ , where the domain of  $g$  includes the range of  $f$ , is the mapping which assigns to each element  $x$  in the domain of  $f$  the element  $g(y)$ , where  $y = f(x)$ . 2. *See* addition. {MECH} The determination of a force whose effect is the same as that of two or more given forces acting simultaneously; all forces are considered acting at the same point. { ,käm-pə'zish-ən }

A myriad of CAFC decisions have relied on this dictionary as authoritative for the meaning of terms used in patent claims. See, e.g., *Masco Corp. v. U.S.*, 64 USPQ2d 1182 (Fed. Cir. 2002) (defining "drive"); *Transclean Corp. v. Bridgewood Services, Inc.*, 62 USPQ2d 1865 (Fed. Cir. 2002) (defining "resilience"); *CCS Fitness, Inc. v. Brunswick Corp.*, 62 USPQ2d 1658 (Fed. Cir. 2002) (defining "member"); *NeoMagic Corp. v. Trident Microsystems, Inc.*, 62 USPQ2d 1482 (Fed. Cir. 2002) (defining "coupling"); *Durel Corp. v. Osram Sylvania, Inc.*, 59 USPQ2d 1238 (Fed. Cir. 2001) (defining "oxide").

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Apparently recognizing the shortcoming of Welch et al. in this regard, the examiner goes on to contend that Oleszczuk et al. and Lickfield et al. "each disclose that at least one of the outer webs may be treated with a treatment agent to render any one of a number of desired properties to the fabric" (Office Action, p. 8, ¶2). This assertion, even if true, does not support the rejection of claim 24 for several reasons. First of all, the two "webs" 14, 16 at issue in Oleszczuk et al. and Lickfield et al. are not directly bonded together, and in fact the references teach away from such an arrangement. Thus, the fact that webs 14, 16 sandwiching an intermediate layer 12 may include "treatment agents" does not in any way meet the terms of claim 24.


Secondly, the examiner has not established or cited any evidence indicating that applying a "treatment agent" in the manner suggested would make the fiber composition different in the layers. In other words, it has not been shown that the "elements or compounds" making up the fibers of each layer 12, 16 would change, even if the treatments mentioned in the references were applied in the manner suggested. Indeed, the examiner expressly admits that Oleszczuk et al. and Lickfield et al. "fail to mention at least one adjacent additional layer of different fiber formulation" (Office Action, p. 3, ¶2), which means that the terms of claim 24 cannot possibly be met by either reference. In the absence of such a showing based on the requisite substantial evidence, the invention of claim 24 as properly construed cannot be considered obvious. Therefore, reconsideration is respectfully requested.

In summary, it is believed that all pending claims patentably distinguish over the prior art. Upon careful review and reconsideration it is believed the examiner will agree with this proposition. Accordingly, the withdrawal of the final Office Action and issuance of a formal Notice of Allowance is earnestly solicited. Any fees required in connection with this response may be debited to Deposit Account 50-0568.



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